

REMARKS

Claims 1-3, 6, 8-10, 13, 15, 16, 18 and 19 remain pending, with claims 1, 2, 8, and 9 being independent.

In the Office Action,¹ the Examiner rejected claims 1-3, 6, 8-10, 13, 15, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,949,877 to Traw ("*Traw*") in view of U.S. Patent No. 5,602,987 to Harari et al. ("*Harari*"), and further in view of U.S. Patent No. 5,450,366 to Watanabe ("*Watanabe*"), U.S. Patent No. 5,912,849 to Yasu et al. ("*Yasu*"), and U.S. Patent No. 5,432,950 to Sibigtroth ("*Sibigtroth*").

Applicants thank the Examiner for careful consideration of this application and for withdrawing the previous grounds of rejection (Office Action at p. 2).

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-3, 6, 8-10, 13, 15, 16, 18, and 19 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

A *prima facie* case of obviousness has not been established because, among other things, none of *Traw*, *Harari*, *Watanabe*, *Yasu*, and *Sibigroth*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Claim 1 recites a combination including, for example,

A memory card comprising:
a storage portion including a public area which is capable of being accessed by an ordinary procedure, the public area including a rewritable public area and a read-only public area on which revocation information is registered ... ; and
a controller which determines whether or not use of the memory card by an electronic device ... is to be revoked, based on the revocation information registered on the read-only public area of the memory card

(emphasis added).

The Examiner concedes that "Traw, Harari, and Watanabe are silent regarding the public area of the memory card including both a rewriteable public area and a read-only public area" (Office Action at p. 4). In an effort to cure this deficiency, the Examiner asserts that "Yasu discloses a memory card include both a rewritable public area and a read-only public area (col. 2, lines 20-67)." This is incorrect. *Yasu* is silent on the claimed "public area including a rewritable public area and a read-only public area." *Yasu* does not teach or suggest the claimed "public" areas, nor do any of the other references cure this deficiency.

Moreover, the Examiner concedes that *Traw*, in view of *Harari*, and further in view of *Watanabe* and *Yasu* fail to teach "that the read-only public area of the memory card contains revocation information, nor that the revocation information stored in said read-only public area is necessarily used to determine that usage of the memory card by an electronic device is to be revoked" (Office Action at pp. 4-5). In an effort to cure

this additional deficiency, the Examiner asserts that *Sibigroth* teaches these elements (Office Action at p. 5). This is also incorrect.

Sibigroth teaches security modes, including a “revocable mode [that] may be changed to either the normal mode of operation or the irrevocable mode of operation by a user-defined key” (*Sibigroth*, abstract, emphasis added; see also *Sibigroth*, col. 6, lines 66-67). Determining whether to revoke access based on a user-defined key, as taught by *Sibigroth*, does not constitute a teaching or suggestion of determining whether to revoke access “based on the revocation information registered on the read-only public area of the memory card,” as recited by claim 1. Moreover, such teachings of *Sibigroth* also do not constitute a teaching or suggestion of a “public area” or a “public area of the memory card,” as recited by claim 1.

In addition to teaching or suggesting each and every element recited by the claims, the references must provide motivation to combine their teachings to arrive at Applicants’ claimed invention. As set forth in M.P.E.P. § 2141.02, it is “this invention as a whole, and not some part of it, which must be obvious under 35 U.S.C. § 103.” *In re Antonie*, 559 F.2d 618, 620 (emphasis in original). Although the Examiner sets forth motivation to add each reference to the “previous combination,” this does not constitute the requisite motivation to combine all of the references to arrive at Applicants’ claimed invention as a whole (Office Action at pp. 3-5). Because the Examiner has not shown that one of ordinary skill in the art would have been motivated to combine the references to arrive at Applicants’ invention as a whole, no *prima facie* case of obviousness has been established for claim 1.

Further, the Examiner relies on improper hindsight to combine *Traw, Harari, Watanabe, Yasu, and Sibigroth* under 35 U.S.C. § 103(a). As M.P.E.P. § 2142 instructs, “the examiner must ... make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” The Examiner’s piecewise reconstruction of the elements recited by claim 1 impermissibly relies on hindsight in combining the alleged teachings of *Traw, Harari, Watanabe, Yasu, and Sibigroth*.

Because none of *Traw, Harari, Watanabe, Yasu, and Sibigroth*, taken alone or in combination, teach or suggest each and every element recited by claim 1 and required by dependent claims 3 and 6, and further because the references do not provide the requisite motivation to arrive at Applicants’ claimed invention, no *prima facie* case of obviousness has been established with respect to these claims. Independent claims 2, 8, and 9, although of different scope, recite similar elements to claim 1 and are therefore allowable for at least the reasons discussed above. Claims 10, 13, 15, 16, 18, and 19 depend from independent claims 2, 8, and 9 and therefore include all of the elements recited therein. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-3, 6, 8-10, 13, 15, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Traw, Harari, Watanabe, Yasu, and Sibigroth*.


In view of the foregoing remarks, Applicants request the Examiner’s reconsideration and reexamination of the application, and the timely allowance of the pending claims. Applicants respectfully request that the Examiner respond to every point raised herein in accordance with M.P.E.P. § 707.07(f). Should the Examiner

continue to dispute the patentability of the claims after consideration of this Reply,
Applicants encourage the Examiner to contact Applicants' undersigned representative
by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,
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